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EXAMINER

FAN, HONGMIN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AYMAN HAMMAD and PHIL DIXON

Appeal 2015-003626
Application 12/332,990
Technology Center 2600

Before JOSEPH L. DIXON, MELISSA A. HAAPALA, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from a final rejection of claims 34, 35, 37, 38, 40, 50–52, 57, 60–62, and 64–70, which constitute all of the claims currently pending in the application. *See* Final Act. 1; Advisory Act. 1 (entering the amendment to cancel claim 63). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

INVENTION

Appellants' invention is directed to radio frequency shielding for portable electronic devices, such as contactless smartcards. Spec. ¶ 1.

Claim 34 is exemplary of the subject matter on appeal:

34. An apparatus comprising:

a cellular phone comprising a first antenna, an electrical filter coupled to the first antenna, and a radio frequency identification (RFID) device coupled to the first antenna via the electrical filter, wherein the first antenna is configured to communicate with an authorized reader in a frequency range, and the electrical filter is configured to filter frequencies outside the frequency range; and

an RF shield comprising an electrically conductive, non-ferromagnetic material, wherein the RF shield is configured to prevent unauthorized transfer of data between a second antenna external to the cellular phone and the first antenna, and wherein the RF shield is further configured to attenuate only signals inside the frequency range passing from the second antenna to the first antenna so that signals passing through the RF shield within the frequency range are attenuated below an activation threshold for the RFID device.

REJECTIONS ON APPEAL

Claims 34, 35, 37, 38, 40, 50–52, 57, 60–62, and 64–70 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3–4.

Claims 34, 37, 38, 40, 57, 62, 64, and 65 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Bason (US 7,243,840 B2; issued July 17, 2007), Labrou (US 7,784,684 B2; issued Aug. 31, 2010), Shafir (US 2005/0073415 A1; published Apr. 7, 2005), and Moskowitz (US 2006/0044206 A1; published Mar. 2, 2006). Final Act. 4–7

Claims 35, 50–52, 60, 61, and 66–70 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over the combination of Bason, Labrou, Shafir, Moskowitz, and various additional references. Final Act. 7–12.

ISSUES

Appellants’ contentions present us with the following issues:

A) Did the Examiner err in rejecting all pending claims under 35 U.S.C. § 112, first paragraph?

B) Did the Examiner establish the combination of Bason, Labrou, Shafir, and Moskowitz teaches or suggests *wherein the RF shield is further configured to attenuate only signals inside the frequency range passing from the second antenna to the first antenna so that signals passing through the RF shield within the frequency range are attenuated below an activation threshold for the RFID device* (“RF shield wherein” limitation), as recited in independent claims 34 and 65?

ANALYSIS

We have reviewed the Examiner’s rejections, Appellants’ contentions, and the evidence of record. Appellants have persuaded us the Examiner has failed to establish that the claims do not comply with the written description requirement or are unpatentable over the cited prior art.

Issue A: 35 U.S.C. § 112, First Paragraph Rejection

The Examiner finds the pending claims do not do not comply with the written description requirement because the Specification does not disclose “the RF shield is configured to attenuate only signals inside the frequency

range,” as recited in both independent claims 34 and 65.¹ In particular, the Examiner finds the Specification’s disclosure is broader than the claimed limitation because it only discloses the RF shield is capable of attenuating the RF signals within the range of operation of the device, but does not say anything about the effect outside the RF range of the operation. *See* Ans. 3.

Section 112, first paragraph, of 35 U.S.C. requires the specification to reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). The claim language at issue is a negative limitation that sets forth the RF shield is configured to attenuate *only* signals inside the frequency range (i.e., does not attenuate signals outside the frequency range). Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation. *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012).

Appellants contend the Specification provides support for the disputed limitation in paragraphs 28 and 29. App. Br. 7–8; Reply Br. 3. The cited portion of the Specification describes “the RF shield 100 may be designed to act as a signal attenuator within the range of that frequency range of operation [for the device].” Spec. ¶ 29. The Specification further describes

¹ The Examiner further finds the Specification does not disclose an additional limitation recited in the independent claims (“RF shield does not attenuate only signals outside the frequency range”). Final Act. 2. However; we agree with Appellants that limitation is not recited in the claims and, therefore, is not a proper basis for a § 112 ¶ 1 rejection. *See* App. Br. 7; Reply Br. 2. Accordingly, as the Examiner does not explicitly withdraw the rejection over this limitation (*see* Ans. 2), we do not sustain the § 112 ¶ 1 rejection for this limitation, to the extent it is still pending.

“the RF shield 100 acts as a mismatched antenna or an RF signal absorber to attenuate those frequencies used for the operation of the contactless portable consumer device 102.” We agree with Appellants that these sections would reasonably convey to one of ordinary skill a reason to exclude frequencies outside the frequency range from the signals for which the RF shield is configured to attenuate. Accordingly, we do not sustain the 35 U.S.C. § 112, first paragraph rejection.

Issue B: 35 U.S.C. § 103(a) Rejections

Appellants contend that obviousness of the claims has not been established because the Examiner fails to point out which reference(s) are interpreted as teaching or suggesting the “RF shield wherein” limitation recited in independent claims 34 and 65. *See* App. Br. 9–10, 12; Reply Br. 3. We agree.

The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). In rejecting claims under 35 U.S.C. § 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). We determine the Examiner has not met this burden.

In the obviousness rejection of independent claims 34 and 65, the Examiner does not make any findings addressing the “RF shield wherein” limitation. *See* Final Act. 4–6, 7. For example, the Examiner does not make any findings explaining how the combination of cited references teaches or suggests the RF shield is configured to *attenuate only signals inside the frequency range* or *so that signals passing through the RF shield . . . are*

attenuated, as set forth in the “RF shield wherein” limitation. *See id.* Nor does the Examiner address this limitation in the Answer. *See* Ans. 4. Therefore, the Examiner does not provide adequate factual basis to establish that claims 34 and 65 would have been obvious over the combination of Bason, Labrou, Shafir, and Moskowitz.

For the foregoing reasons, Appellants persuade us of error in the rejection of independent claims 34 and 65. The Examiner did not find that any of the additional references of record teach or suggest the “RF shield wherein” limitation. Accordingly, we reverse the 35 U.S.C. § 103(a) rejections of independent claims 34 and 65, and the remaining claims, which depend from claim 34 or 65.

DECISION

We reverse the Examiner’s decision to reject claims 34, 35, 37, 38, 40, 50–52, 57, 60–62, and 64–70.

REVERSED